



09/28/2011

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September 26th, 2011

To the Commissioner for Patents:

I am writing regarding the following United States Patents:

6,197,060

6,554,861

The above-cited patents have been the subject of reexamination proceedings which have left significant counts of each patent intact. (see attachments).

I am appealing these reexamination proceedings on the following basis. The attached email from the assignee authorizes me as the original inventor to sub-assign the patents. As an additional assignee, I should have been included as a party to defend the patents in the reexamination proceedings. Therefore, I am submitting this appeal for appropriate USPTO actions.

Please include this correspondence and the attachments in the file wrappers of the above-cited patents. Thank you.

Sincerely,

Dr. Glenn Knox

**GWK/gwk
Attachments**

Print Message

Close this window

From: "Gadsden, Bob" <bob.gadsden@gyrusplc.com> [Add to Address Book](#)
Date: 2006/09/15 Fri AM 06:48:59 EDT
To: <gwknnox@bellsouth.net>
CC: "Ryan, Phil" <phil.ryan@gyrusacmi.com> [Add to Address Book](#)
Subject: RE: RE: Nitinol Implants for implantable hearing aid

Dr Knox,

Many thanks for your fax, and for the reference to the Soundtec website, which does help explain the intended use more clearly. If I am correct in my understanding, the position is as follows;

1. The intended new product is a nitinol clip for securing a magnet to the stapes. The clip would replace the current arrangement of a ring (which requires the surgical separation of the joint to accommodate the ring).
2. The earlier patent (US 6,197,060) covers the use of a nitinol clip in a device for securing one otologic structure to another. This is different arrangement from the one you propose, as the proposal is to secure a magnet to a single otologic structure as opposed to securing one otologic structure to another.

Thus it would appear that your current proposal is a separately licensable idea. It is unusual for a patent attorney such as myself to give an opinion in writing that the patent we control does NOT cover a particular arrangement (ask your patent attorney just how rare this is). However, the situation is clear, and the relationship between you and our company is a strong one, so I wanted to give a straight answer to a straight question.

I wish you and Dr Hough every success with your new idea, and hope that you will continue to deal with Gyrus ENT when you have ideas that would be suitable for us to manufacture.

Thanks and best regards,

Bob Gadsden
Gyrus Group PLC

-----Original Message-----

From: gwknnox@bellsouth.net [mailto:gwknnox@bellsouth.net]
Sent: 14 September 2006 19:30
To: Gadsden, Bob
Subject: Re: RE: Nitinol Implants for implantable hearing aid
Importance: High

If you go to

<http://www.capitaloto.com/direct.htm>

there is a photo of the implant which you can probably see better than the fax. The photo shows a "ring" which slips over the capitulum of the stapes. This requires surgery to temporarily separate the incudostapedial joint. The nitinol modification that we have in mind would replace the ring with two half-rings or one open ring which close together when heated. This would allow attachment without separating the incus from the stapes.

Glenn Knox MD

> From: "Gadsden, Bob" <bob.gadsden@gyrusplc.com>
> Date: 2006/09/13 Wed AM 09:00:14 EDT
> To: <gwknnox@bellsouth.net>
> Subject: RE: Nitinol Implants for implantable hearing aid

File

105-
9415
118

NOTICE OF INTENT TO ISSUE INTER PARTES REEXAMINATION CERTIFICATE

Control No.

95/000,262

Examiner

David O. Reip

Patent Under Reexamination

6,554,861

Art Unit

3993

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

1. ☒ Prosecution on the merits is (or remains) closed in this *inter partes* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office, or upon petition. A Reexamination Certificate will be issued in due course in view of:
 - a. ☐ The communication filed on _____ by _____.
 - b. ☒ Patent owner's failure to file an appropriate timely response to the Office action dated 10 March 2009.
 - c. ☐ The failure to timely file an Appeal with fee by all parties to the reexamination proceeding entitled to do so. 37 CFR 1.959 and 41.61.
 - d. ☐ The failure to timely file an Appellant's Brief with fee by all parties to the reexamination proceeding entitled to do so. 37 CFR 41.66(a).
 - e. ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated _____
 - f. ☐ Other: _____
2. ☒ The Reexamination Certificate will indicate the following:
 - a. Change in the Specification: ☐ Yes ☒ No
 - b. Change in the Drawings: ☐ Yes ☒ No
 - c. Status of the Claims:
 - (1) Patent claim(s) confirmed: _____.
 - (2) Patent claim(s) amended: _____.
 - (3) Patent claim(s) cancelled: 1-8 and 23-30.
 - (4) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
 - (5) New claim(s) patentable: _____.
3. ☐ Note attached statement of reasons for patentability and/or confirmation.
4. ☐ Note attached NOTICE OF REFERENCE CITED, PTO-892.
5. ☐ Note attached LIST OF REFERENCES CITED, PTO-1449 or PTO/SB/08.
6. ☐ The drawings filed on _____ ☐ are ☐ are not acceptable.
7. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. § 119(a) - (d) or (f).
The certified copy has ☐ been received, ☐ not been received,
☐ been filed in Application/Control No. _____ filed on _____.
8. ☒ Note Examiner's Amendment (attachment).
9. ☒ Other (attachment). CLAIMS 9-22 WERE NOT SUBJECT TO REEXAMINATION.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of this Office action.

(12) **EX PARTE REEXAMINATION CERTIFICATE** (7006th)**United States Patent**
Knox(10) **Number:** **US 6,197,060 C1**(45) **Certificate Issued:** **Aug. 18, 2009**(54) **OTOLOGIC PROSTHESES**(75) **Inventor:** **Glenn W. Knox, Jacksonville, FL (US)**(73) **Assignee:** **The Governor and Company of the Bank of Scotland, London (GB)**

5.690.671 A	11/1997	McGurk
5.855.577 A	1/1999	Murphy-Chutorian et al.
5.876.434 A	3/1999	Flomenblit et al.
5.989.242 A	11/1999	Saadat
6.066.083 A	5/2000	Slater et al.

FOREIGN PATENT DOCUMENTS

DE	4210235 C1	11/1993
EP	0909554	10/1998
WO	WO-A 98/24371	11/1998

Reexamination Request:

No. 90/008.649, May 10, 2007

Reexamination Certificate for:

Patent No.: **6,197,060**
 Issued: **Mar. 6, 2001**
 Appl. No.: **09/233,394**
 Filed: **Jan. 19, 1999**

(51) **Int. Cl.**
A61F 2/18 (2006.01)
A61B 19/00 (2006.01)

(52) **U.S. Cl.** **623/10**
 (58) **Field of Classification Search** **None**
 See application file for complete search history.

(56) **References Cited****U.S. PATENT DOCUMENTS**

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3,711,869 A	1/1973	Shea, Jr.
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5,171,240 A	12/1992	Hanwong
5,219,358 A	6/1993	Bendel et al.
5,514,178 A	5/1996	Torchio

OTHER PUBLICATIONS

Eviatar, Abraham. *Otologic Medicine and Surgery*, Chapter 46, "Stapes Surgery," pp. 1261-1267.
 Schuknecht, Harold F., *Surgery of the Ear and Temporal Bone*, Chapter 20, Otosclerosis Surgery, pp. 223-239.
 Jurgen Theissing, "HNO-Operationsletire," pp. 352, 382, George Thieme Verlag Stuttgart (1996).
 Dietrich Plester et al., "Atlas der Ohrchirurgie," pp. 98, 107, 108, 110, Kohlhammer Verlag Stuttgart (1989).
 Hans-Georg Boenninghaus, "Hals-Nasen-Ohrenheilkunde," pp. 138, 139, Springer verlag Berlin (1996).
 Enatsu, K., Utilization of Ni-Ti shape memory alloy for ossicular prosthesis and its biocompatibility with the incus of cats, *Otologia Fukuoka* 32, (1986) 256-269 ('Enatsu')(translation not provided).
 Kasano F., Utilization of nickel-titanium shape memory alloy for stapes prosthesis, *Auris Nasus Larynx* 24 (1997) 137-142 ('Kasano').

Primary Examiner—David O. Reip(57) **ABSTRACT**

Otologic protheses of shape-memory metal alloy self-secure about an otologic structure when heat is applied to a pre-formed bight by means of a laser.

